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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/346,353
Filing Date: July 2, 1999
Appellant(s): Marie Angelopoulos et al.

MAILED

AUG 23 2001

Thomas A. Beck
For Appellant

GROUP 1700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed on July 19, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is substantially correct.

Claims 1-45 are pending.

This appeal involves claims 1-16, 20, 22-25 and 40-42.

Claims 17-19, 21, 26-39 and 43-45 have been withdrawn from consideration, but have not been officially cancelled since they are non-elected claims as evidenced by appellant's election without traverse in paper No. 6.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 7, 11 and 12 are the independent claims and the remaining claims are all dependent claims. Appellant states that claim 1 should

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be the main focus in this appeal as claims 7, 11 and 12 are variations of the method found in claim 1, and provides reasons in section III of arguments as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Han	5,171,478	12-1992
Cao et al.	5,232,631	8-1993
Ikkala et al.	5,520,852	5-1996
Angelopoulos et al.	5,969,024	10-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16, 20, 22, 23 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,969,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly recited additive (claim 1), second material (claim 7) and plasticizer (claim 12) encompass the siloxane of the patent as evidenced by claim 4, Siloxanes for example.

Appellant does not address the obviousness-type double patenting rejection in Appeal Brief. However, the examiner had acknowledged appellant's statement in paper No. 10 filed on December 13, 2000, the submission of the Terminal Disclaimer in the future.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 40-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 24 reciting further presence of monomer of said precursor and an oxidant in addition to an admixture of a solvent, an additive and a polymer does not have support in the originally filed specification, and thus constitutes New Matter. Appellant states "[i]f an oxidative polymerization were done there would be monomers and oxidants in the solution. Also, monomer and oxidants could be subsequently added.". Appellant's statement is directed to an oxidative polymerization *per se*, and the Examiner has clearly indicated that such method will not be examined in the Office Action mailed on May 4, 2000 (paper No. 7) since said method is distinct from the claim 1, a treatment of a polymer. Also, note that a monomer cannot be conducting even with a dopant since an electron cannot travel from one monomer to another monomer. At least an oligomer (several repeating monomeric units) is needed in order to obtain conductivity.

With respect to claims 40-42, the recited additive, material and plasticizer cannot be an oxidant since said oxidant is defined as the substance that gains electrons. However, for example,

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a plasticizer such as an ester of acids cannot gain an electron. Also, note that a plasticizer has been examined as the elected specie as evidenced by the page 2 of paper No. 7.

Contrary to appellant's assertion, the specification does not adequately describe that the oxidant is a plasticizer and provides local mobility to a polymer. The use of said oxidant such as ammonium peroxydisulfate is seen at line 16, page 15 of the specification, however, again it is directed to an oxidative polymerization, not a treatment of a polymer.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478), Ikkala et al (US 5,520,852) or Cao et al (US 5,232,631).

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The process recited in Han, Ikkala and Cao inherently yields the recited at least one crystal grain and material having isotropic electrical conductivity. Examples of the cited art show processing of conducting polymers.

Thus, the instant invention lacks a novelty.

Contrary to applicant's assertion, the instant claim does not recite any particular method of forming at least one crystal grain. The cited art show a treatment of conducting polymers by plasticizers or solvents as in the instant invention. Thus, the process recited in Han, Ikkala and Cao inherently yields the recited at least one crystal grain and material having isotropic electrical conductivity, and applicant failed to show otherwise.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478).

Han teaches a method of plasticizing polyaniline by employing a plasticizer at col. 6, line 21 to col. 7, line 66 and in example 6. The removal of solvent is taught at col. 22, line 57 to col. 23, line 6 also. The recited plasticizers of Han would not substantially dissolve polyanilines in the absence of a solvent, and would provide local mobility to polyanilines. The recited plasticizers of Han would not substantially dissolve in polyanilines neither. Stretching of a film is the art known. Crystalline state is an inherent property in Han since the same materials and process (mixing polyaniline solution with an additive, and then removing a solvent) are used in Han and the instant invention. Thus, the instant invention lacks a novelty.

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Appellant asserts that there is no teaching or suggestion of the rest of the limitations of the instant claims in Han. Contrary to appellant's assertion, the examiner did not acknowledge that Han does not teach using a solvent. Rather, Han teaches the instant invention in the example 6, as pointed out in the past Office Action, **the use of a plasticizer (tripropylamine) and a solvent (N-methyl pyrrolidinone)** is taught in example 6. Note that a polyaniline would not be substantially soluble in said plasticizer, tripropylamine, or in other plasticizers taught by Han at col. 6, line 21 to col. 7, line 66 as evidenced by Han's teaching, a plasticizing agent will soften and increas the flexibility of all or part of the polyaniline, at col. 6, lines 27-29. It dose not teach said plasticizing agent will dissolve said polyaniline. The instant specification does not teach any particular method other than dissoving a conducting polymer in a solvent, adding a plasticizer and then removing said solvent, which is precisely taught by Han. Thus, the properties of the product would be the same inherently. The discovery of inherent properties from the known process alone does not warrant patentability.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478) in view of Cao et al (US 5,232,631).

The claim 6 recites a stretch oriented film over Han. However, stretch orienting of a film is a routine proactice in the art as taught by Cao, col. 5, lines 61-62.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to stretch orienting the film of Han by teaching of Cao since films are known to subject to a stretch orientation in order to improve physical properties.

Appellant fails to traverse the instant rejection in Appeal Brief.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cao et al (US 5,232,631).

Cao teaches a method of plasticizing polyaniline by employing a plasticizer, surfactant, at col. 14, line 44 to col. 15, line 50 and in examples. The recited plasticizers of Cao would not substantially dissolve polyanilines in the absence of a solvent, and would provide local mobility to polyanilines. The recited plasticizers of Cao would not substantially dissolve in polyanilines either. Stretching of a film is the art known. Crystalline state is an inherent property in Cao since the same materials and process (mixing polyaniline solution with an additive, and then removing a solvent) are used in Cao and the instant invention. Thus, the instant invention lacks a novelty.

The same reasoning in above "Han" is applied.

Appellant is correct that the rejection of claims 5, 9 (and 15) under 35 U.S.C. 112, first paragraph had been withdrawn in the last Office Action.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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